



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/893,246

06/26/2001

Daniel R. Marshall

10002308-1

4906

7590

01/10/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HINDI, NABIL Z

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,246

Applicant(s)

MARSHALL, DANIEL R.

Examiner

NABIL Z HINDI

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 2 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

In response to applicant's letter dated August 23, 2004, the following action is taken:

Claim 7 please amend the claim to delete the limitation ""and figure 8"

The claims are rejected for the same reasons set forth in the previous office action mailed May 24, 2004 repeated herein.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (5557596) in view of Katsumura et al (6307826).

The primary reference shows an optical reading apparatus having the same structural elements as shown in fig 1A corresponding to fig 1A of the claimed invention. However the reference does not show the use of an electron beam deflector. The secondary reference discloses the use of an electron beam deflector for the purpose of positioning the beam on a desired location as shown in fig 1 elements 16 and 18. It would have been obvious to one skilled in the art at the time the invention was made to use the teachings of the secondary reference and modify the primary reference. Such modification of using a beam steering mechanism is merely an alternative engineering capability as opposed to moving the medium in order to eliminate the medium positioning apparatus. Thus one skilled in the art would have been motivated to use the

Art Unit: 2655

teachings of the secondary reference for the purpose of positioning the beam at a desired location using a beam steering mechanism as opposed to a medium positioning mechanism.

With respect to the limitations of the dependent claims see figs 1A-5 of the primary reference.

Claims 2 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited prior art shows the use of a first and second set of electrodes for deflecting the light beam into a first direction and a second direction being perpendicular to the first direction as shown in fig 3

Claims 19 and 20 allowed.

None of the cited prior art shows or teaches the steering mechanism as claimed and shown in fig 3.

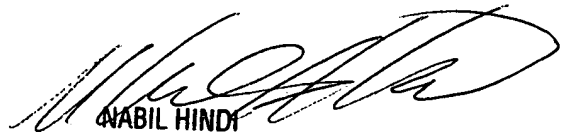
Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive. In response to applicant's arguments centered around the prior art not showing motivation, teachings and/or some suggestion to combine references. It is noted that arguing one reference does not suggest the modification to the other reference is merely a review of the positive statements in the reference in a literary manner for what they say to a layman, and it is not a technological or engineering evaluation as to whether the reference establish that the difference is one that would

Art Unit: 2655

have been obvious to one skilled in the art. See *In re Sernaker* 217 USPQ 1. the claims are drawn to the limitation "electron beam steering mechanism" which is interpreted by the examiner as any combined system to deflect, focus, track the beam on the medium. The secondary reference shows the use of a steering mechanism combining the elements 19 to deflect the light beam, element 19 to deflect the light beam in a focusing direction, which meets the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


NABIL HINDI
PRIMARY EXAMINER
GROUP 2800
2800